

Remarks

I. Status of the Application and Claims

On May 7, 2001, Applicants submitted a response to an Office Action dated February 7, 2001. In this, Applicants cancelled claims 8-11 and introduced claims 12-15. Subsequently, Applicants received an Office Action dated July 19, 2001 alleging that our previous submission was non-responsive because the newly introduced claims were directed to an invention in a non-elected restriction group. The canceled claims 8-11 were being pursued by Applicants in a continuation-in-part application. Applicants have now reintroduced claims corresponding to canceled claims 8-11 and will pursue claims 12-15 in a continuation-in-part application.

II. The Amendments

The claims that have been introduced in the present response are essentially claims 8-11 that were previously canceled. The reintroduction of these claims was in direct response to the allegation in the present Office Action that the previous cancellation of these claims and introduction of claims 12-15 constituted an attempt by Applicants to pursue an invention in a non-elected restriction group. The amended claims do not add new matter to the application and their entry is therefore respectfully requested.

The Rejections

I. Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph

On page 2 of the Office Action, the Examiner rejects claim 8 as being indefinite due to the inclusion of the word "good." Since this word is no longer in the claims as amended herein, this basis of rejection has been obviated.

The Examiner also questions the use of the word "fineness" in claims 10 and 11 (now claims 18 and 19). Applicants submit that this term is not unclear to one of skill in the art in light of the definition provided on page 9 of the application, lines 21-32. This reads in part:

Particle fineness is characterized by the average, volume-weighted particle diameter MTG (D(4.3)) measured by laser diffraction (Malvern Instruments, model 2600c).

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Values of $\leq 11 \mu\text{m}$, in particular of $\leq 10 \mu\text{m}$, are achieved for the silicas according to the invention, which are higher than for customary silicas ($\geq 12 \mu\text{m}$).

In light of the above, Applicants submit that the term "fineness" is not indefinite and respectfully request that the Examiner's rejection be withdrawn.

II. Rejection of Claims Under 35 U.S.C. § 102/103

On page 2 of the Office Action, the Examiner rejects all pending claims under 35 U.S.C. § 102(b), or in the alternative, under 35 U.S.C. § 103. The rejections are based upon either of two references, Lagarde, *et al.* (U.S.C. 4,704,425) and Johnson, *et al.* (U.S.C. 4,681,750). These same references were previously used to reject claims and the rejections were the subject of an Examiner's Answer. In the present Office Action, the Examiner notes that "intended use does not limit the product claimed."

Applicants respectfully traverse this rejection.

A. Allegations of Inherency are Unsupported

In order to constitute an anticipation, a single reference must teach all of the elements of a claimed invention either expressly or inherently. In the present case, the Examiner has rejected claims based upon the allegation that Lagarde discloses a silica with a BET of 242, a CTAB of 237 and a BET/CTAB ratio of 1.02. Even though the cited references do not expressly teach the other characteristics required by the present claims, the Examiner suggests that all of the elements not expressly taught can be presumed to be present from the properties that *are* disclosed, *i.e.* that the Examiner alleges that the undisclosed elements are inherent.

Applicants do not agree with this conclusion. In order to be inherent, an element must be the necessary consequence of that which is expressly taught. The examiner alleges inherency but provides no explanation as to why, given the parameters disclosed in the references, the pore volume, silanol group density, average aggregate size, DPB value or V_2/V_1 ratio of a precipitated silica must fall within the range set forth in Applicants' claims. It is submitted that, in fact, inherency does not exist for the claimed invention and that, in its absence, there is no basis for rejecting claims on novelty grounds.

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B. Applicants' Filed Declarations Provide Evidence that Silicas Disclosed in the Cited References are Different from Those Claimed

The Examiner argues that the fitness of a product for a particular use is inherent in its composition. This is correct. However, the reverse is also true, *i.e.*, the physical characteristics of a product are a reflection of its composition. Precipitated silicas that are chemically the same, should produce rubber products that behave identically. The behavior of precipitated silicas was examined in two Declarations Under 37 CFR §1.132 filed by Applicants on November 2, 1998. The first of these is dated September 4, 1997 and discusses experiments designed to compare the silica of Lagarde with that of Applicants. The second is dated October 15, 1998 and compares silica made by the process of Johnson with that of Applicants. The Examiner disregarded these references based upon the argument that they compare the vulcanized products made using the silicas rather than the silicas themselves.

The Examiner's disregarding of the test results presented in these Declarations is unwarranted. The tests conducted are appropriate because they reflect the way in which the silicas behave in a product of intended use. Moreover, since the other relevant parameters used in making the compared compositions (*i.e.*, except for the silicas) were essentially the same, it is reasonable to conclude that the differences discussed in the Declarations are a direct result of differences in the silicas themselves. It was found that the silicas of the present invention produce a product with characteristics superior to that made using the silica of either Lagarde or Johnson. Based on the results obtained, one of skill in the art would conclude that the silicas disclosed in the cited references are neither the same as, nor obvious variants of, the silicas claimed. Moreover, given the differences with respect to the intended use of the silica claimed compared to the intended use of the silicas of Lagarde or Johnson, there is no motivation to modify the silicas presented in those references to more closely correspond to those claimed by Applicants.

C. The Cited References Do Not Enable Particles of Less Than 11 Microns

Claim 18 of the present application requires an average particle fineness of less than 11 microns and claim 19 of less than 10 microns. In contrast, Lagarde discloses a particle size of less than 45 microns. The Examiner alleges that this teaching subsumes Applicants' silicas. However, a teaching of an upper limit on particle size does not mean that any particle smaller than the upper limit can be made. There is nothing in the teachings of Lagarde to

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suggest that the procedures described therein could result in silica particles having a size falling within the range required by the present claims. Thus, the reference fails to enable particles with the required sizes.

Conclusion

In light of the amendments and discussion above, Applicants submit that all of the Examiner's rejections under 35 U.S.C. §§ 112, 102, and 103 have been overcome. It is therefore respectfully requested that these rejections be withdrawn and that the claims presently pending in the application be allowed.

If, in the opinion of the Examiner, a phone call may help to expedite the prosecution of this application, the Examiner is invited to call Applicant's undersigned attorney at (703) 905-2173.

Respectfully submitted,

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